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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/034,966	12/26/2001	Antoine Kawam	00216-529001 / T-681	9312

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EXAMINER	
LAMM, MARINA	
ART UNIT	**PAPER NUMBER**
1616	

DATE MAILED: 02/08/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/034,966	KAWAM ET AL.	
	Examiner	Art Unit	
	Marina Lamm	1616	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *05 November 2004*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-9,11-13,15-20 and 27-30* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-9, 11-13, 15-20 and 27-30* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Acknowledgment is made of the amendment filed 11/5/04. Claims pending are 1-9, 11-13, 15-20 and 27-30. Claims 31-54 have been cancelled. Claims 1, 16 and 27 have been amended.

Claim Rejections - 35 USC § 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 1-9, 11-13, 15-20 and 27-30 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claims 1 and 27 as amended introduce new matter as they use the phrase "wherein the personal care formulation, the propellant and the sorbant are in fluid contact with each other within the container". There is no support in the specification for the employment of the phrase "in fluid contact with each other" in the claims. The instant specification describes a personal care product comprising within a container, a personal care composition, an open-celled foam and propellant. See Examples. All three components are in contact with each other within the container. However, the specification lacks the description of "fluid contact". Thus, the open-celled foam sorbant

is a solid substance, which is gelled after it absorbs at least some of the propellant; the propellant is a gas. The only "fluid" in the container is the personal care composition. The limitation "in fluid contact with each other" was not described in the application as filed, and persons skilled in the art would not recognize in the applicant's disclosure a description of the invention as presently claimed. Therefore, it is the examiner's position that the disclosure does not reasonably convey that the inventor has possession of the subject matter of the amendment at the time of filing of the instant application.

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 1-9, 11-13, 15-20 and 27-30 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1 and 27 as amended recite the limitation "wherein the personal care formulation, the propellant and the sorbant are in fluid contact with each other within the container." It is unclear what exactly is meant by the phrase "in fluid contact". The phrase is especially confusing in context of Claim 3, which recites that the first (gas) portion and the second (gel) portion of the propellant "comprise substantially all of the propellant." Therefore, there is no "fluid" propellant present in the container. Further, the sorbant of the instant claims is "an open cell foam, that has formed a gel with at least a portion of the propellant." Therefore, the sorbant is a solid substance or a gel,

and not a "fluid" either. Thus, the recitation of "fluid contact" renders the instant claims vague and indefinite.

Claim Rejections - 35 USC § 102

5. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

6. The rejection of Claims 1-6, 9, 11, 12, 15-20, 27 and 28 under 35 U.S.C. 102(b) as being anticipated by Alexander (US 3,964,649) is maintained for the reasons of the record.

Claim Rejections - 35 USC § 103

7. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

8. The rejection of Claims 1-9, 11, 12, 15-20 and 27-30 under 35 U.S.C. 103(a) as being unpatentable over Watson (US 3,858,764) in view of Benoist (US 6,527,150) is maintained for the reasons of the record.

9. The rejection of Claim 13 under 35 U.S.C. 103(a) as being unpatentable over (1) (US 3,858,764) in view of Benoist (US 6,527,150) and further in view of de LaForcade et al. (US 6,464,111) and Villars (US 5,451,396) or (2) Alexander (US 3,964,649) in view of de LaForcade et al. (US 6,464,111) and Villars (US 5,451,396) is maintained for the reasons of the record.

10. The rejection of Claims 29 and 30 under 35 U.S.C. 103(a) as being unpatentable over Alexander (US 3,964,649) in view of Watson (US 3,858,764) is maintained for the reasons of the record.

Response to Arguments

11. Applicant's arguments filed 11/5/04 have been fully considered but they are not persuasive.

With respect to the Alexander reference, the Applicant argues that the reference "does not teach or suggest a sorbant consisting essentially of an open cell foam." "The only disclosure of open cell foam in Alexander is as a vapor-permeable wall, not as a sorbant." See pp. 6-7 of the reply. In response, the "reservoir" of Alexander contains a vapor-permeable wall made of open cell foam such as polyethylene or polypropylene foam, and silica. See col. 2. The open cell foam of Alexander will inherently act as a sorbant for the propellant because it is the same foam as disclosed herein. Also, the propellants are the same in the reference and instant invention. Further, it is noted that the claim language "consisting essentially of" does not exclude the presence of additional components unless the Applicants provide evidence that the presence of those additional components "would materially affect the basic and novel characteristics of the claimed invention." See MPEP 2111.03 citing *In re Hertz*, 537 F.2d 549, 551-52, 190 USPQ 461, 463 (CCPA 1976).

With respect to the Watson reference, the Applicant argues that the reference "does not teach or suggest a sorbant consisting essentially of an open cell foam."

Further, the Applicant argues that Watson teaches away from using open cell foam because open cell foam would absorb components of the composition. See p. 7 of the reply. In response, it is noted that Watson's statement cited by the Applicant appears to be taken out of context. Watson is concerned with potential contamination of the product within the container by reservoir material which may absorb or dissolve some components of the product "to an extent which would cause the dispensed concentrate product to be significantly changed in character." See col. 5, lines 3-14. Such statement cannot be reasonably interpreted as teaching away from using open cell foam reservoir material. Watson explicitly teaches that his reservoir materials have to absorb propellant and either form a solution with the propellant or swell in the propellant. See col. 7-9.

In response to the Applicant's argument that there is no suggestion to combine the Watson and Benoist references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Benoist teaches using open or semi-open cell foams to trap the liquid phase of the propellant and Watson teaches the desirability of propellant absorption and retention in the reservoir. It would have been obvious to one having ordinary skill in the art at the

time the invention was made to modify the dispensers of Watson such that to employ open cell foam as a sorbant/propellant retainer. One having ordinary skill in the art would have been motivated to do this to obtain the desired absorption and retention of the propellant in the sorbant/retainer as suggested by Benoist.

Conclusion

12. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL.** See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marina Lamm whose telephone number is (571) 272-0618. The examiner can normally be reached on Mon-Fri from 11am to 5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Kunz, can be reached at (571) 272-0887.

The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Gary L Kunz

GARY KUNZ
SUPERVISORY PATENT EXAMINER
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2/4/05